

Application No.: 09/220,910
Amendment Date: May 23, 2006
Reply to Office Action dated: November 23, 2005

REMARKS/ARGUMENTS

Claims 2, 5-15, 17-21 and 23-41 are pending in the present application. Claims 2, 5-15, 17-21 and 23-41 are rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement. Claims 2, 5-15, 17-21 and 23-41 are rejected under 35 U.S.C §112, first paragraph, as failing to comply with the enablement requirement. Claims 2, 5-15, 17-21 and 23-41 are rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2, 5-15, 17-21, 23-41 are rejected under 35 U.S.C. §103 as being obvious over Krause (US Patent No. 5,526,520) in view of Wanatabe (US Patent No. 6,372,612 B1). Claims 2, 5-15, 17-21, 23-41 are rejected under 35 U.S.C. §103 as being obvious over Bobo, (US Patent No. 5,675,507) in view of Fabbio (US Patent No. 5,870,089). In this Amendment, claims 1-41 are hereby cancelled without prejudice or disclaimer. New claims 42-77 are added.

REJECTIONS UNDER 35 U.S.C. §112, first paragraph

With regard to the §112, first paragraph rejections, Applicants submit new claims 42-77 overcome any previous rejections.

REJECTIONS UNDER 35 U.S.C. §112, second paragraph

Former claims 2, 5 through 15, 17 through 21 and 23 through 41 stood rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

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(i.e., *un-selected indicator or unspecified location is not disclosed in specification*).

Applicant respectfully traverses any similar rejection with regard to new claims 42-77.

While the word “un-selected” may not literally appear in the specification, one skilled in the art would recognize and know how to practice the claimed invention using “un-selected indicator” upon reading the specification. As to definiteness, the prosecution history clarifies the phrases to mean a location whose address is not specified and an indicator that has not been selected by a user, respectively. As such, the phrases are “fairly simple and intelligible, [and] capable of being understood in the context of the patent specification. It is thus reasonably clear what the invention is and that the patent specification conveys that meaning.” All Dental Prodx, LLC et al. v. Advantage Dental Products, Inc., 309 F.3d 774, 779 (Fed. Cir. 2002). As Judge Lourie stated in All Dental:

The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. Warner-Jenkinson, 520 U.S. at 28-29. That determination requires a construction of the claims according to the familiar canons of claim construction. Only after a thorough attempt to understand the meaning of a claim has failed to resolve material ambiguities can one conclude that the claim is invalid for indefiniteness. **Foremost among the tools of claim construction is of course the claim language itself, but other portions of the intrinsic evidence are clearly relevant, including the patent specification and prosecution history.** See Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985) (“The specification is, thus, the primary basis for construing the claims. . . . [T]he prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance.”). **The prosecution history can thus be relied upon to clarify the claim meaning and hence provide definiteness.** Tex. Instruments Inc. v. Int’l Trade Comm’n, 871 F.2d 1054, 1063, 10 USPQ2d 1257, 1263-64 (Fed. Cir. 1989) (“The public is entitled to know the scope of the claims but *must look to both the patent specification and the prosecution history*, especially when there is doubt

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concerning the scope of the claims.” (citing McGill Inc. v. John Zink Co., 736 F.2d 666, 221 USPQ 944 (Fed. Cir. 1984))).

(Bolding and Italics added by Applicant.) (See All Dental 309 F.3d at 779-780)

Likewise, it is well settled case law that in order to meet the written description requirement, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.” See All Dental 309 F.3d at 779, (citing Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing Vas-Cath, 935 F.2d at 1562, 19 USPQ2d at 1115, and In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976))). In fact, “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” See All Dental 309 F.3d at 779, (citing Eiselstein, 52 F.3d at 1039, 34 USPQ2d at 1470. In the present application, the invention clearly involves a system and method for processing the contents of a primary document to locate an indicator that is merely present (*i.e.*, un-selected by a user) in the primary document, identifying a secondary document associated with the un-selected indicator, and encapsulating the secondary document within the primary document. Similarly, it is also clear that the invention does not involve a system and method for embedding indicators linked to specific files/locations that are only processed after they are selected by a user, as in the Krause and Bobo, II patents.

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Applicants submit that the claims in their present form overcome all 35 U.S.C. §112, second paragraph issues and are allowable in their present form.

In addition, former claims 2, 5 through 15, 17 through 21 and 23 through 41 also stood rejected under 35 U.S.C. ' 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (*i.e., attaching said secondary document to said primary document to encapsulate said secondary document within said primary document*). Applicant respectfully disagrees, traverses the rejection and submits that support for the relevant limitations may be found at least at page 4, lines 13-14 of the specification.

Therefore, Applicants submit that the claims in their present form overcome all 35 U.S.C. §112, second paragraph issues and are allowable in their present form.

REJECTIONS UNDER 35 U.S.C. §103

A. Krause-Watanabe

Former claims 2 through 9, 12 through 15, 17 through 21 and 23 through 41 stand rejected under 35 U.S.C. §103 as being obvious over U.S. Patent No. 5,526, 520 to Krause in view of U.S. Patent No. 6,372,612 to Watanabe. Applicant respectfully disagrees and asserts that new claims 42-77 overcome any §103(a) rejection based on Krause and Watanabe.

Applicants submit there is nothing in the Krause patent that discloses or suggests "processing said primary document to locate an un-selected indicator; identifying said

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secondary document associated with said located un-selected indicator . . .,” as recited in claim 42. Instead, the Krause patent operates only after the selection of a hotspot 55 (indicator) to identify the secondary document based on information in the selected hotspot (see column 4, lines 51 – 65). Similarly, there is nothing in the Watanabe patent that discloses or suggests the above-recited elements from claim 42 that are missing from the Krause patent. Therefore, Applicants submit there is no basis for combining the two cited references to support a proper §103 rejection of claim 42 in its present form, and it is respectfully requested claim 42 be allowed.

Therefore, for at least those reasons given above for claim 42, claims 56, 61, 65, 68 and 69, as well as those claims depending, respectively, therefrom, overcome any §103(a) rejection based on Watanabe in view of Krause as well. Accordingly, it is respectfully requested that these claims be allowed in their present form.

B. Bobo-Fabbio

Former claims 2, 5 through 15, 17 through 21 and 23 through 30 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,675,507 to Bobo, II in view of U.S. Patent No. 5,870,089 to Fabbio. Applicant respectfully disagrees and asserts that new claims 42-77 overcome any §103(a) rejection based on Bobo and Fabbio.

Applicants submit there is nothing in the Bobo, II patent that discloses or suggests “processing said primary document to locate an un-selected indicator; identifying said secondary document associated with said located un-selected indicator . . .,” as recited in claim 42. Instead, the Bobo, II patent discloses a Message and Storage Delivery System

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(MSDS) that receives and stores facsimile, voice and data messages and notifies the recipient of the messages via a generated e-mail that a message has been received (see Abstract). Specifically, the Bobo, II patent MSDS operates by receiving a message (primary document) (step 50) for an intended recipient, storing the message (step 54) for the intended recipient, notifying the intended recipient of the message (step 56), converting the message to an HTML document (tertiary document) based on user preferences (step 58), receiving a request from the intended recipient for information on the stored message (step 76), generating a separate listing (secondary document) of the received message and other messages either with or without embedded HTML images (tertiary documents) of the message(s) (steps 102, 112, 120, 130 and 150), and moving (sending) the file to the Internet Server (step 104). (See FIGs. 2, 3, 4A and 4B; column 7, lines 3 – 12, 38 – 50; column 9, line 46 – column 10, line 26.) In other words, in the Bobo, II patent, the secondary document is not “attach[ed] . . . to said primary document to encapsulate said secondary document within said primary document,” as recited in claim 42. Similarly, there is nothing in the Fabbio patent that discloses or suggests the above-recited element from claim 42 that is missing from the Bobo, II patent. Therefore, Applicants submit there is no basis for combining the cited references to support a proper §103 rejection of claim 42 in its present form, and it is respectfully requested claim 42 be allowed.

Therefore, for at least those reasons given above for claim 42, claims 56, 61, 65, 68 and 69, as well as those claims depending, respectively, therefrom, overcome any

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§103(a) rejection based on Bobo in view of Fabbio as well. Accordingly, it is respectfully requested that these claims be allowed in their present form.

Response to Arguments

In reply to the Examiner's statements in paragraph 4, page 3 of the outstanding Office Action, the following comments are provided.

As shown in Applicant's response to the §112 rejection above, the specification and subsequent prosecution history clearly do disclose the un-selected indicator. Likewise, there is nothing in the specification that would indicate to the Examiner that the un-selected indicator should be interpreted so broadly as to include the Examiner's "... pointer, locator, URL, address, etc." In fact, the only definitions and examples of an indicator provided in the specification can not be interpreted so broadly. For example,

In accordance with the present invention, the indicator may include several different types of indicators. In a first exemplary embodiment, the indicator may be one of several individual words or characters that typically indicate that a secondary document should be attached. In a second exemplary embodiment, the indicator may be one of a plurality of phrases that may typically indicate that a secondary document should be included. In a third exemplary embodiment, the existence of an indicator may be determined by using syntactic processing (otherwise known as natural language processing). (Page 2, 5th full paragraph.) (Bolding and underscoring added by Applicant.)

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In addition, the present invention may enable the user to add additional terms or phrases to the possible indicators to personalize the system or method for each specific user. Thus, the present invention may allow a user that employs terminology or characters that may not be commonly used. Furthermore, once the system or method according to the present invention determines that a secondary document should be attached, the system or method may also determine either a potential filename or location of the secondary document. (page 3, 1st paragraph.) (Underscoring added by Applicant.)

The plurality of indicators may include a plurality of predetermined words that are typically used to indicate that a related document should be attached to primary document 50. Some examples of predetermined words include “attached,” “enclosed,” “included,” and “attachment.” Those skilled in the art will understand that these are merely examples and that other words or characters may be included in the plurality of indicators without departing from the scope of the present invention. (Page 4, 1st full paragraph.) (Bolding and underscoring added by Applicant.)

In accordance with the present invention, indicator table 70 may also include phrases or sets of words, instead of individual words or characters, that are typically used to indicate that a related document should be attached. For example, some exemplary phrases may include “I (or We) have attached,” “I (or We) have enclosed,” “I (or We) have included,” “Please find enclosed,” “Attached is the file,” etc. Detecting phrases such as these instead of individual words or characters should result in a reduction of “false-positives” that would occur in the previous embodiments. False-positives occur when the processor detects a word or character included in indicator

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table 70, but instead of being an indication of a related document, the word or character may merely be just another word in the document. For example, a sentence in primary document 50 may read, "The wheel is attached to the axle of the car." The previous embodiments would detect the word "attached" and determine that a related document should be attached, which would probably not be the case. However, this third embodiment would not determine that a related document should be attached since the phrase "The wheel is attached" would probably not be included in indicator table 70. (Page 6, 1st full paragraph.) (Bolding and underscoring added by Applicant.)

In a further exemplary embodiment of the present invention, the user may be allowed to add additional entries to any of the tables (e.g., indicator table 70, subject table 72 and associations table 74). Thus, the user may further personalize the system by adding slang terms, additional phrases, personalized references, nicknames or associations to the respective tables in accordance with the present invention. (Page 9, 1st full paragraph.) (Underscoring added by Applicant.)

Any of the previous embodiments may be implemented to solve this CC list problem using approaches similar to those discussed above with respect to attaching secondary document 50. One modification may be to change the indicators which are sought to be detected in primary document 50. Instead of words such as "attached," or phrases such as "I have attached," the indicators may include words or phrases indicating that a person/entity should be on the CC list, such as the term "CC" or phrase "I have CC'd." (Page 9, 4th full paragraph.) (Bolding and underscoring added by Applicant.)

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With regard to new claims 42-77, the subject matter of all of the former rejections of claims 2, 5 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. §103 are believed to be overcome, and it is respectfully requested that the rejections be withdrawn and a notice of allowance to that effect be issued. Therefore, the Examiner is respectfully requested to withdraw his interpretation and conform it to the definitions clearly enumerated in the specification.

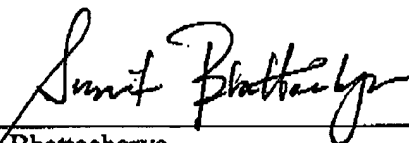
For at least the above reasons, Applicants respectfully submit that the present case is in condition for allowance and respectfully requests that the Examiner issue a notice of allowance.

The Office is hereby authorized to charge any fees determined to be necessary under 37 C.F.R. §1.16 or §1.17 or credit any overpayment to Kenyon & Kenyon LLP
Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application.

Respectfully submitted,

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